

**REMARKS**

**I. Introduction**

In response to the pending Office Action, Applicants have amended claims 12 and 14 in order to overcome the § 112 rejections. No new matter has been added. In addition, claim 13 has been cancelled, without prejudice, in order to overcome the objection as being dependent upon a cancelled claim.

Applicants respectfully point out that the Office Action Summary contains an error which states that the Office Action is responsive to communications filed on November 13, 2008. The correct date should read November 13, 2007.

For the reasons set forth below, Applicants respectfully submit that all pending claims as currently amended are patentable over the cited prior art.

**II. The Rejection Of Claims 1, 3-10 And 12-14 Under 35 U.S.C. § 103**

Claims 1, 3-10 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arrington et al. (USP No. 6,586,683). Applicants respectfully traverse this rejection of the pending claims for at least the following reasons.

With regard to the present invention, amended claim 1 recites an electronic component comprising: a conductive pattern provided on an insulating substrate; a metal film formed by a plating method on a surface of the conductive pattern; and a metal oxide layer formed by oxidizing the metal film and disposed on the surface of the conductive pattern, wherein the metal oxide layer is formed on a portion of the substrate between electrodes of the conductive pattern on the substrate.

In the Previous Response of November 13, 2007, Applicants pointed out that Arrington shows that there is no copper oxide layer coated between the electrode pads and as such, Arrington fails to disclose each and every limitation of claim 1.

The Response to Arguments section of the pending Office Action agrees with this position. On page 4, lines 15-17, it states that “[in Arrington] the copper oxide layer is only formed onto the conductive pads and wiring traces, whereas in the present invention the copper oxide layer is formed onto at least a portion of the electrode pads and a portion of the substrate between the electrodes.” Thus, it is admitted that Arrington fails to disclose a copper oxide layer coated between the electrode pads. However, the Office Action further states that “since Applicant has not specifically stated any advantages of having the copper oxide layer between the pads, the Examiner is taking the position that the present invention is actually one step backward from the prior art because to make Applicant’s structure, Arrington would not have to mask or deliberately avoid the copper oxide layer between the electrode pads and wiring traces.”

This argument is faulty for a myriad of reasons. Foremost, the Examiner’s position appears to be pure speculation. There has been no rationale provided by the Examiner, nor does there appear to be any teaching or suggestion in the cited prior art to take the above mentioned position other than by merely saying so. However, saying so does not make it so. Accordingly, as Arrington does not disclose the above cited limitation, it does not render claim 1 obvious.

Furthermore, Applicants would remind the Examiner that it has long been established that unless there is clear proof that claims are obvious, an Applicant is entitled to a patent under the United States Patent Code. It has never been a requirement in USPTO patent practice to disclose an advantage of a claim over the prior art *when the claim does not read upon the prior art*. It is the Examiner’s burden to show that the differences are not significant and therefore,

obvious. Again, as no evidence has been provided to suggest that these differences are not significant, the Examiner has failed to meet this burden.

However, contrary to the Examiner's position, the Applicants have expressly stated an advantage of having a copper oxide layer formed onto at least a portion of the electrode pads and a portion of the substrate between the electrodes. Page 6, lines 20-24 of the specification recites,

“According to the foregoing structure, an insulating thin film of uniform thickness is formed on the conductive patterns and the spaces between the conductive patterns on the substrate. As a result, a more reliable electronic component is obtainable although its conductive patterns have a high aspect ratio”.

Thus, the Applicants have stated specific rationale for an advantage associated with having the copper oxide layer between the electrodes, which the Examiner appears to have overlooked while reviewing the specification.

Moreover, page 4 of the pending Office Action states that “to make Applicant's structure, Arrington would not have to mask or deliberately avoid the copper oxide layer between the electrode pads and wiring traces”. This by itself is an advantage!! In the present invention, the expense and difficulty in masking the structure to prevent the oxide from being formed in between the electrodes would be avoided, making the process cheaper and easier than the process described in Arrington. As such, the Examiner has disproved the basis of the argument set forth in the rejection. Accordingly, it is clear that the rejection of claim 1 is clearly improper and invalid.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As Arrington fails to teach or suggest an electronic component comprising: a conductive pattern provided on an insulating substrate; a

metal film formed by a plating method on a surface of the conductive pattern; and a metal oxide layer formed by oxidizing the metal film and disposed on the surface of the conductive pattern, wherein the metal oxide layer is formed on a portion of the substrate between electrodes of the conductive pattern on the substrate, it is submitted that Arrington does not render claim 1 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claim 1 and any pending claims dependent thereon be withdrawn.

**III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

**IV. Conclusion**


Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication of which is respectfully solicited.

**Application No.: 10/541,321**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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